

REMARKS/ARGUMENTS

Responsive to the Official Action mailed December 3, 2003, applicant has further amended the claims of his application in an earnest effort to place this case in condition for allowance. Specifically, independent claims 17 and 18 have been canceled, and independent claim 12 amended. Reconsideration is respectfully requested.

In paragraphs 20 and 21 of the Action, the Examiner has rejected the pending claims under 35 U.S.C. §112. Reference is respectfully made to page 10, line 7, of applicant's specification which clearly discloses use of an elastomeric polymer emulsion, as claimed. It is believed that this rejection can be withdrawn.

In the Action, the Examiner has maintained his rejection of the pending claims under 35 U.S.C. §112, with significant reliance upon the dicta of the Board of Appeals in In Re Slob. Applicant must respectfully maintain that reliance on this isolated case, without study of its underlying facts in comparison to the present application, hardly provides applicant a fair basis for consideration of his pending claims.

Applicant has characterized In Re Slob as "isolated" since applicant *could not find a single citation* of this case (search conducted March 3, 2004; search results attached).

In the Action, the Examiner repeatedly quotes from In Re Slob, but specifically avoids any discussion of its underlying facts. In that case, the Board objected to the claims at issue since it considered the claims to "merely set forth physical characteristics", and to "not [set] forth specific compositions which would meet such characteristics".

That is simply not the case with the presently pending claims. Applicant's claims specify *a particular composition* of applicant's fibrous precursor web, and a specific *final basis weight*.

Applicant specifies processing by *hydroentanglement* on a specifically configured *three-dimensional image transfer device*.

Applicant's claims further specify *substantially uniform, saturation application* of a pre-finish, and further specify that the finish comprises *an elastomeric polymer emulsion*. A curing step is specified, followed by a subsequent dyeing step.

The amount of finish applied is specified by the resultant *structural characteristics* of the fabric, as can be tested in accordance with accepted ASTM test protocols. Such structural features *are not vague and indefinite*, but to the contrary, are clearly recognized by those skilled in the art, as are the claimed combined drape value, and combined blend value.

Applicant's claims have been revised to further specify the level of *color fastness* achieved in accordance with applicant's specifically recited fabric formation. As discussed in the specification, applicant's invention contemplates that application of the pre-dye finish, followed by dyeing of the nonwoven fabric, provides a fabric which exhibits desirably high abrasion resistance and color fastness.

In a sense, applicant's claims are analogous to specifying a metallic composition formed by a specified heat-treating process, which achieves a specified level of structural hardness. Those skilled in the art would recognize and understand the intended scope of such claims, as is clearly the case in the present application.

The Examiner places significant reliance upon the In Re Slob decision, but does not appear to have fully studied the Board's statements therein. The Board specifically referred to the holding in Austenal Laboratories, Inc. v. Nobilium Processing Company of Chicago et al., 115 U.S.P.Q. 44, a copy of which is attached. In that case, the U.S. District Court for the

Northern District of Illinois, referenced Therm-O-Proof Insulation Co. v. Slayter & Co., 80 F2d, 557, 28 U.S.P.Q. 98, concluding that the following claim language was invalid and void for indefiniteness:

Said material being of sufficiently light weight and devoid of free moisture content of sufficient amount to cause bulging or other injurious effects upon the exposed surfaces of said walls.

The Court in Therm-O-Proof went on to state:

Unfortunately for the validity of the claim, greater indefiniteness and more vagueness could hardly be found. It is so worded (accidentally or intentionally) as to catch an alleged infringer coming or going.

Applicant must respectfully maintain that a study of the underlying facts of In Re Slob, as well as a study of the decisions upon which the Board based its rulings, show that reliance on this case in rejecting the claims of the present application is misplaced and inappropriate.

As applicant previously noted, M.P.E.P. Section 2173.01 specifically provides the manner in which applicants may claim their invention:

They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought (citation omitted).

In the Action, no comment was offered in connection with this specific provision of the M.P.E.P., but rather, reference was simply made to the language of In Re Slob, without any consideration of its underlying facts, or underlying precedent.

Accordingly, it is respectfully maintained that the rejection under 35 U.S.C. §112 should be withdrawn.

In rejecting the claims under 35 U.S.C. §103, the Examiner now relies upon *five* separate prior references. Without belaboring the point, applicant must respectfully maintain that this very strongly suggests that the Examiner is impermissibly being guided by *hindsight* and *applicant's own disclosure* in picking and choosing among the diverse teachings of the various references.

In the Action, the Examiner has rejected the pending claims under 35 U.S.C. §103, with reliance upon U.S. Patent No. 5,874,159, to Cruise et al., in view of U.S. Patent No. 5,098,764, to Drelich et al., U.S. Patent No. 3,966,406, to Namiki et al., U.S. Patent No. 5,266,354, to Tohyama et al., and U.S. Patent No. 3,988,343, to Lilyquist. In applicant's previous responses, the acknowledged deficiencies in the teachings of these references in teaching or suggesting applicant's invention have been extensively discussed, but applicant feels he must reiterate these points in an effort to refute what appears to be a piecemeal selection of prior art teachings, with guidance of applicant's own claims.

The principal Cruise et al. reference clearly contemplates a fabric structure which is distinctly different than that set forth in the presently pending claims. As stated at column 2, lines 16 *et seq.*, Cruise et al. contemplates:

The composite fabric structure comprises **two layers** of fabric bonded together such that the bonding is done with **discrete bonding points between the layers** in relatively close space to one another. In particular, the bonds encompass portions of fibers from layers of fabric **without substantially penetrating through to the outer surface** of at least one of the layers of fabric (emphasis supplied).

As further stated in Cruise et al., at column 4, line 48 *et seq.*, the nature of the bonding is further discussed:

A further observation is that it is important that the connections adjacent globules are substantially broken or **nonexistent**. . . . If the globules were substantially interconnected, they would tend to make the composite fabric stiffer. The discrete bonding points **do not make a continuous film layer** in the middle of the fabric but are in discrete globules that neither connect with each other **nor penetrate to the surface of the fabric**.

Not only is there no abrasion data set forth in the Cruise et al. patent, Cruise et al. specifically contemplates the provision of binder at *discrete globule locations* with *isolation of* the binder globules. Clearly, this principal reference does not teach *substantially uniform, saturation application of a pre-dye finish*, as claimed.

In the Action, the Examiner states that the principal reference, Cruise et al., "differs from the claimed invention **"because it is silent about the image transfer device to form an imaged nonwoven fabric, dyeing, and pre-dye finish or coating"**. In the Action, the Examiner states that "Drelich describes an image transfer device to form an imaged nonwoven fabric with enhanced physical properties and fabric with pleasing appearance". Clearly, this is essentially a tacit admission that Drelich et al. fails to teach or suggest the specifically recited structural characteristics of fabric configured in accordance with applicant's pending claims.

While applicant acknowledges that Namiki et al. discloses a process for jet dyeing fibrous articles, there is little question but that this reference fails to teach or suggest applicant's fabric as claimed, including saturation application of a pre-dye finish to achieve specified levels of abrasion resistance and color fastness.

As previously noted, applicant is unaware of any teaching whatsoever in Tohyama et al. of employing the techniques disclosed therein for enhancing *abrasion resistance*. In fact, applicant must respectfully maintain that it would be inappropriate to combine the teachings of this reference with the principal Cruise et al. reference, since the references are addressing completely different problems.

Tohyama et al. specifically contemplates the use of porous inorganic particles, whereby a dispersed dye is caught within the fine pores of the inorganic particles. There is clearly nothing in this reference itself which would suggest combining its teachings with the diverse teachings of the other references relied upon by the Examiner in formulating the present obviousness rejection.

M.P.E.P. Section 2143.01 specifically admonishes that "the prior art must suggest the desirability of the claimed invention", and that "the mere fact that references *can* be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**" (citation omitted; emphasis supplied). The principal Cruise et al. reference clearly *does not* teach saturation application of a pre-dye finish. Tohyama et al. contemplates application of porous inorganic particles, *without any teachings relating to abrasion resistance*. Combining these diverse, inapposite teachings, guided by applicant's own pending claims, cannot provide a proper basis for rejection under 35 U.S.C. §103.

In the Action, the Examiner has not explained the significance of the newly cited Lilyquist patent, the *fifth* reference relied upon in the rejection under 35 U.S.C. §103. In any event, it is clear that the teachings of this reference, particularly directed to a coating on a nylon

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fabric whose essential components include titanium dioxide pigment, tinting pigments, and an optical brightening agent, clearly fails to overcome the acknowledged deficiencies in the teachings of the principal Cruise et al. patent.

In view of the foregoing, formal allowance of claims 12-16, and 19-25 are believed to be in order and is respectfully solicited. Should the Examiner wish to speak with applicant's attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fee which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

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Attachment:

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **March 3, 2004**.

